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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,278	11/01/2001	William J. Fidler	22308-67662	9008

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JOHN W. GOLDSCHMIDT, JR. ESQUIRE  
DILWORTH PAXON LLP  
3200 MELLON BANK CENTER  
1735 MARKET STREET  
PHILADELPHIA, PA 19103

EXAMINER

EPSHTEYN, ALEXANDER

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/000,278	<b>Applicant(s)</b> FIDLER, WILLIAM J.	
	<b>Examiner</b> Alex Epshteyn	<b>Art Unit</b> 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant contends that the claimed method is for a "commercial-free" game show, yet the claims clearly direct the displaying of commercials throughout the game show, making the game show anything but commercial-free.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the scope of the claim would be because the claim recites a game show without any further structural limitations.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 is directed to a method of generating revenue from a network-televised game show, yet it is unclear from the claim how the revenue is being generated.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because it is directed to both an apparatus and a method. Such a claim is non-statutory subject matter.

Claim 10 is also rejected under 35 U.S.C. 101 the claimed invention is directed to non-statutory subject matter. A game show is non-statutory subject matter since it does not anticipate any tangible result.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by the Jeopardy, Wheel of Fortune, and Price is Right game shows.

Since claim 10 is a product by process claim and does not include any structural limitations, any game show anticipates claim 3. Thus, the game shows of Jeopardy, Wheel of Fortune, or the Price is Right, which are all notoriously well known in the art, anticipate claim 3.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guyett (US Patent 6,764,395) and further in view of Kravitz et al. (US Patent 5,545,088).

In regards to claim 1-3, 6-9, and 11, Guyett teaches of a game comprising displaying to a contestant a segment of an advertiser's commercial, receiving a response from a contestant concerning the commercial segment, wherein a correct response identifies the product displayed in the commercial segment (4: 5-40). The game of Guyett can be played on the Internet or in a televised game show format, where the commercial is displayed to both the contestant and the general public (5: 44-52). Guyett also teaches of presenting advertising surveys to the public (4: 41-45). While Guyett does not explicitly teach of displaying the entirety of the commercial to the contestant, it would be obvious for one skilled in the art to show the entirety of the commercial for both advertising purposes and for purposes of displaying the correct answer in its entirety so that each contestant has the opportunity to view the proper response and to verify the authenticity of the response. Further, while Guyett does not explicitly teach of the procedure of using the teachings for a game show, it is obvious to

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one skilled in the art that a game show format typically involves selecting a predetermined number of contestants prior to participating in the game, and providing each contestant with the rules of the game.

Guyett teaches of a plurality of formats for playing the underlying advertisement game (6: 55-62). Guyett fails to teach of one variation of the advertisement game show that would involve a bingo type format. Kravitz, however, in the same field of endeavor, teaches of a bingo type game show format in which contestants are provided with a game board with a set of random numbers (4: 18-40). A master game board is provided that is used by a host to call out random numbers selected and the numbers are lit up after they are selected (4: 42-47). If a random number displayed on the master game board appears on a board of a contestant, then that particular number on the contestant board is lit up as well (9: 5-18). The winner is declared in a bingo style, if they register numbers forming a horizontal, vertical, or diagonal line of squares (5: 18-25). Kravitz further teaches of a feature of the game where a contestant can select a number to add to their game board if a random selection is shown up on the master game board (9: 25-58). It would be obvious for one skilled in the art to incorporate a reselected random number as the random selection that would initiate winning a special session in which they could win or loose squares. It would be obvious for one skilled in the art to incorporate an additional game such as the one taught by Kravitz into the game show format as taught by Guyett to create an additional and exciting advertisement game play option.

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In regards to claims 4 and 5, Guyett in view of Kravitz do not explicitly teach of a contestant game board comprising 49 squares or a game board comprising randomly generated number between 1 and 60 and one additional number greater then 60.

Kravitz instead teaches of a game board comprising 25 squares. However, it is an obvious matter of design choice to one skilled in the art to increase the game board of Kravitz from 25 squares to 49 squares and to include random generated numbers from the set of 1 to 60, since applicant provides no reason that a game board of 49 squares and random numbers in the range of 1 to 60, provides an advantage or solves a stated problem. Further, one skilled in the art would have expected applicants invention to work just as well with a game board of 25 squares or any other set of random numbers.

***Conclusion***

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex Epshteyn whose telephone number is 571-272-5561. The examiner can normally be reached on M-F 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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XUAN M. THAI  
SUPERVISORY PATENT EXAMINER  
TL3700